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| 09/663,333      | 09/18/2000  | Goran Nilsson        | 3491-42             | 3777             |

7590 01/15/2003  
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EXAMINER

LOPEZ, CARLOS N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1731

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/663,333

Applicant(s)

NILSSON ET AL.

Examiner

Carlos Lopez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 1 Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide support for the newly added limitation that the transfer of a tissue web is improved due to resettable degree of roughness as compared with a transfer belt with a web-contacting surface not having a pressure-sensitive resettable degree of roughness. The specification does not provide a comparison of a belt having no resettable roughness to one that does have resettable roughness.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2 Claims 1-6 and 8 rejected under 35 U.S.C. 103(a) as obvious over Steiner et al (US 5393384) in view of Eklund et al (US 5298124). Steiner uses a belt to guide a paper web through an extended nip press and to transfer the web onto a fabric (16.1) which transfers it to a yankee cylinder, forming an extended transfer nip (Fig. 2).

Steiner is silent as to using a pressure responsive belt. However, Eklund's claim 1 discloses a paper web transfer belt for the use in a paper machine having a supporting base and a top melted layer containing polymer and or a filler particle. The top melted layer having an air permeability less than  $6 \text{ m}^3/\text{m}^2/\text{min}$ , a resettable surface roughness in the range of  $R_z = 2 - 80 \mu\text{M}$ , polymer coating hardness in the range of Shore A 50 to Shore A 97, and the filler contained in the polymer layer having a hardness different from that of polymer coating. A roughness of  $R_z = 0 - 20$  when the polymer layer is compressed by a linear load of  $20 \text{ kN/m} - 200 \text{ kN/m}$  is applied to the transfer belt (Column 16 lines 52-57). The air permeability of the belt was measured according to "Standard Test Method for Air Permeability of Textile Fabrics", ASTM D737-75 (Column 8 lines 15-18). The filler comprising the belt may be kaolin clay (Claim 21). The polymer coating may be a polyurethane/polycarbonate resin composition (Claim 28). Eklund also discloses that the carrier (woven base) may be woven to produce an endless transfer belt once installed in a paper machine (Column 13 lines 23-36). Eklund also discloses in the abstract that the transfer belt can readily release the paper web due to its recovered uncompressed roughness property onto a dryer fabric where it then may be transfer to a dryer cylinder (Bridging Paragraph of Columns 5-6). Eklunds' elements 7- 8, 29-30 and 46-47 in figures 1-3 disclose the belt being used in a press nip. It would have been obvious to a person of ordinary skill at the time the invention was made to have substituted Steiner's transfer with Eklund's transfer belt because it would easily transfer the paper web to a dryer pick-up.

Claim 1 additionally recites that the transfer of a tissue web is improved due to resettable degree of roughness as compared with a transfer belt with a web-contacting surface not having a pressure-sensitive resettable degree of roughness. However said limitation would be expected as pointed out by Eklund which states that due to its resettable roughness property the belt provides a release properties necessary to transfer the web to other papermaking elements.

As for claim 5, the polymer layer encloses a portion of the carrier as shown in figure 4.

#### ***Allowable Subject Matter***

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose or reasonably suggest providing an embossed belt having the claimed properties recited in Applicant's claim 7.

#### ***Response to Arguments***

Applicant's arguments filed 11/04/02 have been fully considered but they are not persuasive. Applicant argues that there is no motivation to combine the Steiner reference with Eklund. It is held that substituting Steiner's conventional papermaking transfer belt with an improved papermaking transfer belt of Eklund would have been obvious to a person of ordinary skill in the art in order to take advantage of Eklund's properties as disclosed in columns 5-6. As disclosed by Eklund, a transfer belt having

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the claimed limitations provides properties that readily release a web onto a dryer pick-up fabric. Claim 1 recites using a transfer belt for conducting a web through a shoe press nip in the press section and from the shoe press nip to a drying cylinder of a dryer section. The drying cylinder forms, together with a transfer means, a transfer nip transferring the web from the transfer belt to the drying cylinder. Figure 2 of Steiner provides a transfer belt (2) for conduction a web through a shoe press nip in the press section and from the shoe press nip to a drying cylinder of a dryer section wherein the drying cylinder (20) forms, together with a transfer means (pick-up fabric 16.1), a transfer nip transferring the web from the transfer belt (2) to the drying cylinder (20). In view that Eklund teaches that a transfer belt having the properties as claimed by Applicant provides release properties to easily transfer a web from the belt onto a pick-up fabric (Bridging Paragraph, Column 5-6), it would have been obvious to one of ordinary skill in the art to have substituted Steiner's belt 2 with Eklund's belt in order to easily have transferred the web onto a pick-up fabric of a dryer section.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,340,413 ('413). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of '413 provides a an endless embossed transfer belt having the claimed properties of Applicant's claim 1, forming an extended transfer nip with a yankee cylinder. The scope of the terms "essentially impermeable" and "polymer layer", recited in claim 13, encompass Applicant's limitations of claims 2-4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



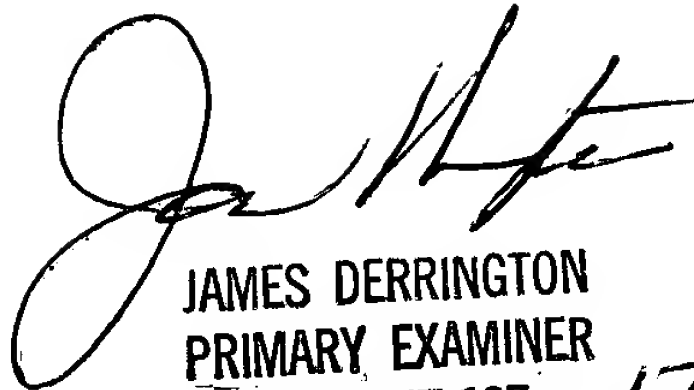
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C.L

January 13, 2003

  
JAMES DERRINGTON  
PRIMARY EXAMINER  
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